

REMARKS

Claims 1, 2, and 4 to 15 are now pending and being considered.

It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

With respect to paragraph two (2), claims 1, 5 to 7, 12 and 15 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,147,473 ("Koo") in view of Minamiura et al., U.S. 2002/0000787 A1.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

The Minamiura reference refers to a method for charging battery packs in a hybrid vehicle having a plurality of battery units. In this context, it is proposed to optimize the charging so that charging is performed using two different charging methods. In the first charging method, charging is performed using a large electric current. This charging takes place until the pressure in a battery cell, measured with the aid of a sensor, rises to a limiting value. After that, charging is performed using a lower current, in order to prevent a further pressure increase. In addition, paragraph 0037 (cited by the Examiner) indicates that, at a charge state of 100%, in a third charging method (or discharging method), a discharge of the battery is undertaken, to lower the pressure. How this discharging as undertaken is not described in the cited document.

However, from this place in the text, the Office conclusorily concludes that there is a deactivation of the charging device; that is, a deactivation occurs as to the generator used for the battery charging. However, this is not described or suggested at any place in the cited document. It is only stated that a discharge is undertaken.

The Minamiura reference does not show the claimed subject matter, whether taken alone or in combination with the other references, because of the following differences:

In Minimiura., charging is performed using different currents, and in the claimed subject matter of claim 1, in the first charging method, regulation is performed to a constant voltage.

In Minimiura, different charging methods are used to reduce the pressure, their selection taking place as a function of the measured pressure. In the claimed subject matter of claim 1, in the second charging method, a dynamization is achieved (for instance, a better mixing through of the battery acid), and the two charging methods are selected independently of the pressure, that is, the pressure is not measured at all.

Finally, in the claimed subject matter, in the second charging method, a discharge is undertaken by switching in a user or by a de-excitation of a charging device, that is, of the generator, whereas in Minamiura it is not stated at all how the discharging is undertaken after the maximum charge is attained.

The combination of Koo and Minamiura do not yield the claimed subject matter without any problem, since, even if two different charging methods were mentioned for battery charging, this is not done to implement the advantages and benefits resulting from the claimed subject matter, as provided for in the specification.

Accordingly, claim 1 is allowable, as are its dependent claims 2, 4 to 11 and 14.

Claims 12, 13 and 15 include features like those or analogous to those of claim 1, and are therefore allowable for essentially the same reasons as claim 1.

As further regards the obviousness rejections, it is respectfully submitted that the cases of In re Fine, *supra*, and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Office's generalized assertions that it would have been obvious to modify or combine the references do not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Office Action reflects a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead

that individual to combine the relevant teachings of the references.
This it has not done. . . .

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original).

That is exactly the case here since it is believed and respectfully submitted that the present Office Action offers no evidence whatsoever, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify or combine references to provide the claimed subject matter of the claims to address the problems met thereby. Accordingly, the Office must provide proper evidence of a motivation for modifying or combining the references to provide the claimed subject matter.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a “technologically simple concept” — which is not the case here — there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed,” stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as

opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper *prima facie* case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). Here again, there have been no such findings to establish that the features discussed above of the rejected claims are met by the reference relied upon. As referred to above, any review of the reference, whether taken alone or combined, makes plain that the reference simply does not describe the features discussed above of the rejected claims.

It is therefore respectfully submitted that claims 1, 2 and 4 to 15 are allowable for these reasons.

With respect to paragraph three (3), claims 2 and 8 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,147,473 ("Koo") (and apparently in view of Minamiura et al., U.S. 2002/0000787 A1) in view of Roseman, U.S. Patent No. 5,623,197.

Claims 2 and 8 depend from claim 1. It is therefore respectfully requested that the obviousness rejections be withdrawn since dependent claims 2 and 8 are allowable for essentially the same reasons as claim 1 as presented, and since the "Roseman" reference does not cure the critical deficiencies of the "Koo" reference or Minamiura, which were explained above. This is because any review of the secondary "Roseman" reference makes clear that it simply does not in any way disclose or suggest the claim 1 features, as explained above, and that it does not cure and is not asserted to cure the deficiencies of the Koo or Minamiura references. Accordingly, claims 2 and 8 are allowable.

With respect to paragraph four (4), claim 9 was rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,147,473 ("Koo") (and apparently in view of Minamiura et al., U.S. 2002/0000787 A1) in view of Kohl, U.S. Patent No. 5,594,321.

Claim 9 depends from claim 1. It is therefore respectfully requested that the obviousness rejections be withdrawn since dependent claim 9 is allowable for essentially the

same reasons as claim 1 as presented, and since the “Kohl” reference does not cure the critical deficiencies of the “Koo” reference or Minamiura, which were explained above. This is because any review of the secondary “Kohl” reference makes clear that it simply does not in any way disclose or suggest the claim 1 features, as explained above, and that it does not cure and is not asserted to cure the deficiencies of the Koo or Minamiura references. Accordingly, claim 9 is allowable.

With respect to paragraph five (5), claims 10 and 11 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,147,473 (“Koo”) (and apparently in view of Minamiura et al., U.S. 2002/0000787 A1) in view of Maechara, U.S. Patent No. 6,777,905.

Claims 10 and 11 depend from claim 1. It is therefore respectfully requested that the obviousness rejections be withdrawn since dependent claims 10 and 11 are allowable for essentially the same reasons as claim 1 as presented, and since the “Maechara” reference does not cure the critical deficiencies of the “Koo” reference or Minamiura, which were explained above. This is because any review of the secondary “Maechara” reference makes clear that it simply does not in any way disclose or suggest the claim 1 features, as explained above, and that it does not cure and is not asserted to cure the deficiencies of the Koo or Minamiura references. Accordingly, claims 10 and 11 are allowable.

With respect to paragraph six (6), claim 13 was rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,147,473 (“Koo”) (and apparently in view of Minamiura et al., U.S. 2002/0000787 A1) in view of Bertness, U.S. 2003/0025481.

Claim 13 includes features analogous to those of claim 1 and is therefore allowable for essentially the same reasons since the “Bertness” reference does not cure the critical deficiencies of the “Koo” reference or Minamiura, which were explained above. This is because any review of the secondary “Bertness” reference makes clear that it simply does not in any way disclose or suggest the claim 1 or analogous claim 13 features, as explained above, and that it does not cure and is not asserted to cure the deficiencies of the Koo or Minamiura references. Accordingly, claim 13 is allowable.

With respect to paragraph seven (7), claim 14 was rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,147,473 (“Koo”) (and apparently in view of Minamiura et al., U.S. 2002/0000787 A1) in view of Cheiky, U.S. Patent No. 6,459,243.

Claim 14 includes features like those of claim 1 and is therefore allowable for essentially the same reasons since the “Cheiky” reference does not cure the critical deficiencies of the “Koo” reference or Minamiura, which were explained above. This is

because any review of the secondary "Cheiky" reference makes clear that it simply does not in any way disclose or suggest the claim 1 or claim 14 features, as explained above, and that it does not cure and is not asserted to cure the deficiencies of the Koo or Minamiura references. Accordingly, claim 14 is allowable.

It is therefore respectfully submitted that claims 1, 2 and 4 to 15 are allowable.

Conclusion

It is therefore respectfully submitted that all of claims 1, 2 and 4 to 15 are allowable. It is therefore respectfully requested that the rejections be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is respectfully requested.

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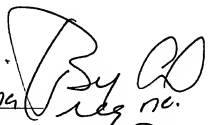
Respectfully submitted,

By: 

Gerard A. Messina
Reg. No. 35,952

KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200

CUSTOMER NO. 26646


reg no.
35,952
HAYSON C. DEPITCH